

Appl. No. 10/034,639
Amdt. Dated July 20, 2005
Reply to Office Action of April 29, 2005

Attorney Docket No. 81752.0118
Customer No.: 26021

REMARKS/ARGUMENTS

Claims 1-23 are pending in the application. Claims 1-23 are submitted to clearly distinguish patentably over the prior art for the reasons discussed hereafter.

In paragraph 5 which begins on page 2 of the Office Action, claims 1-10, 12-21 and 23 are rejected Under 35 U.S.C. § 103(a) as being unpatentable over Savitch in further view of Sedgewick. In paragraph 6 which begins on page 8 of the Office Action, claims 11 and 22 are rejected Under 35 U.S.C. § 103(a) as being unpatentable over Savitch and Sedgewick in further view of U.S. Patent 6,149,325 of Nunokawa et al. These rejections are respectfully traversed.

As previously noted by Applicant, Savitch and Sedgewick are said in the Office Action to disclose all of the limitations of claims 1, 12 and 23 of the present application. In this connection, however, Applicant respectfully refers the Examiner to some of the steps of the present invention. Because of such steps (i.e., the last step in claim 1), there can be achieved the advantages as described at line 26 of page 8 through the last line of page 9. In particular, the present character processing method and apparatus according to the present invention make it possible to select the text for processing without carrying out any special operation for reading/writing the same or other text. Furthermore, in this case, it is not required to display the plurality of text simultaneously, and therefore a large-size display screen is not needed, as discussed at lines 24-26 of page 9.

In this connection, the Office Action simply refers to pages 610 and 611 of Savitch, implying that such advantages can also be attained by Savitch. However, this is clearly not so. Savitch relates only to programming text having in mind no problems at all related to the prior art, such as that described on page 2 in the last paragraph of "prior art" and "object" in the "Summary Of The Invention" thereof.

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Simply describing the method of programming as in Savitch without any relation to the concrete problems simply will not lead a person skilled in the art to the method in accordance with the present invention so as to thereby solve the problems noted above.

Accordingly, the Office Action appears to be simply picking fragments of disclosures from the references such as Savitch without any relation to the "problems to be solved by the invention", "advantages that can be attained by the invention", and so forth. In this connection, the Examiner's attention is directed to the decision of January 6, 2005 by the United States Court Of Appeals for the Federal Circuit in the matter of Teleflex, Incorporated and Technology Holding Company v. KSR International Co., copies of appropriate portions of which are attached hereto. In particular, the Examiner's attention is directed to the Court's statement on page 11 thereof that "the test requires that the nature of the problem to be solved be such that it would have lead a person of ordinary skilled in the art to combine the prior art teachings in the particular manner claimed" citing Rouffet, 149 F. 3d at 1357. And on pages 14 and 15 thereof, the Court states that the District Court erred as a matter of law "by applying an incomplete teaching-suggestion-motivation test to it obviousness determination". The Court further stated that genuine issues of material fact exist as to "whether a person of ordinary skill in the art would have been motivated".

In the present instance, Savitch must be said to relate only to programming text having in mind no problems at all related to the prior art, thereby offering no motivation at all to the inventor to look to or to combine the references for a solution.

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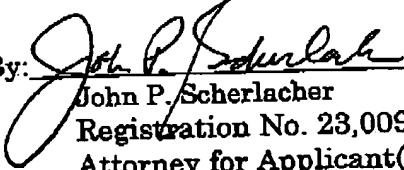
Therefore, claims 1-23 are submitted to clearly distinguish patentably over the attempted combination of Savitch and Sedgewick and the further combination of those two references with Nunokawa.

Reconsideration and allowance in view of the above comments are respectfully requested.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,
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